IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 29-04-2008

CORAM

THE HONOURABLE MR. JUSTICE P.K. MISRA
AND
THE HONOURABLE MR. JUSTICE K. CHANDRU

O.S.A.NO.287 OF 2006
and
M.P.NO.1 OF 2006

Falcon Tyres Limited,
Rep. by its Chief Executive Officer,
KRS Road, Metagulli,
Mysore 570 016. .. Appellant

Vs.

TVS Srichakara Tyres Limited,
Rep. by its Secretary P. Ramesh
7B, West Veli Street,
Madurai 625 001. .. Respondent

Appeal filed under Order 36 Rule 9 of the Original Side Rules read with clause 15 of the Letters Patent against the order dated 31.7.2006 in Appln.No.2042 of 2006 in O.A.No.284 of 2006 in C.S.No.254 of 2006.

For Appellant : Mr.P.S. Raman
Senior Counsel for
Mr.S.K. Srinivasan

For Respondent : Mr.R. Subramanian
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J U D G M E N T

P.K. MISRA, J

The plaintiff / respondent filed C.S.No.254 of 2005 against the present appellant for granting permanent injunction restraining the defendant (present appellant) from in any way selling its Zebra 101 / Challenger 101 or any other tyre with the same tread pattern as the plaintiff's Dragon tyre and also for a further direction to furnish accounts from the date of launching of such products and further claiming Rs.10,01,000/- as damages. During pendency of such suit, the plaintiff filed O.A.No.284 of 2006 for passing an order of interim injunction.

2. Learned single Judge had initially granted an ex-parte order of ad-interim injunction. Thereafter, the present appellant filed Appln.No.2042 of 2006 arising out of O.A.No.284 of 2006 in C.S.No.254 of 2006 for vacating such ad-interim injunction. By order dated 31.7.2006, the learned single Judge, while dismissing such Appln.No.2042 of 2006, made the ad-interim order of injunction absolute, resulting in filing of the present appeal at the instance of the defendant.

3. While the appeal was entertained, an order of interim stay was passed by the Division Bench on 27.9.2006. Subsequently, when the matter came up for final disposal, the Division Bench, at that stage, disposed of such appeal by observing that the interim stay in the appeal is to be made absolute and by giving liberty to the parties to move before the learned single Judge for an early hearing, preferably within a period of 3 months.

4. The plaintiff / respondent, however, filed Civil Appeal No.692 of 2007 before the Supreme Court. The Supreme Court by its order dated 12.2.2007 has set aside such order dated 5.12.2006 in O.S.A.No.287 of 2006 and remitted the appeal to the High Court for fresh disposal of on merits. That is how the appeal has came up for final hearing.

5. We have heard Mr.P.S. Raman, Senior Counsel, for the appellant and, Mr.R. Subramanian, for the respondent.

6. Learned single Judge observed :-
6.The definition of a design under Section 2(d) of the Act would show that a design is only a configuration, shape or other features. It is not necessary that the entire product should be new. It is the shape, configuration, pattern, ornament, lines or a combination of these factors that should be a new one. In this connection there is no other model produced before me in showing that the combination of the lines, configuration and pattern adopted tread pattern of the plaintiff has been adopted by some other tyre company. An endeavor was made in showing the similarity between the plaintiffs tread pattern and Dunlop Tyre. But I find striking variation and dissimilarity in between two. In the absence of similar pattern it has to be found that there is some unique feature in the plaintiff's tread pattern. Of course the plaintiffs act of registration under the Design Act may not confer a right thereon. But to say that there was no new feature in the plaintiffs pattern cannot be accepted. It cannot also be countenanced that all tyres have buttons and that there is nothing in the shape of the button. It is not only the size of the button but also the placement of them to ultimately form a design is something unique that the plaintiff had. Again to say that it is only surface pattern that was registered and no tread pattern cannot be accepted. All surfaces of tyres will have a pattern and that pattern depends not only upon the size of the button but also upon its configuration or the process of placement in order to make out a particular phase to the surface. Analgisly of human mouth will contain teeth but it is upon the configuration of teeth of individuals vary. Likewise all persons are having thumbs but the impressions that make the difference. Therefore to say that surface pattern alone is registered and that the registration is quite new lend of support of the applicants/defendants' cases and so long as that is a particular pattern or design adopted by the plaintiff company in manufacturing the particular tyre.

It was further observed :-
11. The only test in infrignement of designs and passing off is the sameness of the features in the goods of plaintiff and defendants that has been expressed in AIR 1968 Calcutta 109 at page 111, which is as follows :-
The definition itself lays emphasis on the fact that the sameness of the features is to be decided by the eye, that is by seeking the two and getting a total synoptic view of the same. The sameness of features do not necessarily mean that the two designs must be identical on all points and differ on no point.

12. The learned counsel for the applicant/defendant submitted that there are lot of differences in between the tyres of the plaintiff and defendant and based upon which no infringement of design could be alleged by the plaintiff. Various decisions in an action for an infringement was mentioned in AIR 2000 Madras 497. It has been highlighted that whatever differences in between the original and infringed article may be it is only the overall substantial similarity that would be taken into consideration and not obscure and minute dissimilarity found by Microscopic Examination.

7. Learned Senior Counsel appearing for the appellant has submitted that the order of interim injunction had been passed by the learned single Judge even without recording any conclusion regarding the similarity or otherwise in the design. It has been further contended that registration of the design in the name of the plaintiff itself is invalid being contrary to the provisions contained in the Designs Act, 2000. In this context, it is further contended that the learned single Judge has possibly construed the cause of action as one of passing off without carefully going through the averments made in the plaint and also the relief sought for.

8. As per Section 2(d) of the Designs Act, 2000 "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article ... by any industrial process or means, ... which in the finished article appeal to and are judged solely by the eye; ... and does not include any trade mark ... or property mark ... or any artistic work ...

Section 4(b) envisages that a design, which is not disclosed to the public by publication in tangible form or by use or in any other way prior to the date of application for registration, shall not be registered.
Section 11(1) contemplates that when a design is registered, the registered proprietor of the design shall have copyright in the design during ten years from the date of registration.
Section 19(1)(b) contemplates that an interest person may present a petition for the cancellation of the registration of a design on the ground that the design has been published in India or in any other country prior to the date of registration.
Section 22(1) envisages that it shall not be lawful for any person for the purpose of sale to apply to any article the design or any fraudulent or obvious imitation thereof without the licence or consent of the registered proprietor.
Section 22(3) contemplates that in any suit or proceeding for relief under Section 22(2), every ground on which the registration of a design may be cancelled under Section 19 is available as a ground of defence.

9. Law is well settled that, while considering the order of interim injunction as contemplated under Order 39 Rule 1 and 2 CPC., the Court is required to find out a strong prima facie case in favour of the plaintiff. In addition to the above, the court is also required to find out whether injunction is not granted, the plaintiff is likely to suffer irreparable loss and, in addition, the court is also required to find out balance of convenience, in case the injunction is granted or refused.

10. In the present case, the question relates to the design of the two wheeler tyres. The tyres manufactured by the plaintiff is named as "Dragon", whereas the tyres manufactured by the defendant is known as "Challenger". In the typed set of papers produced by the appellant, colour photographs of the two tyres in question are available. A bare look at those photographs clearly indicate that the design or pattern in the two tyres are conspicuously different, visible even to the naked eye. Merely because some of the patterns may appear similar from certain angle, it cannot be said that the design which was registered by the plaintiff has been copied. Even the tyres do not look alike to prima facie give rise to a case of passing off. Learned single Judge apparently without considering the matter in its proper perspective, has simply passed an order of injunction.

11. It is of course true that, while considering an appeal against an order of interim injunction, the appellate court is slow to interfere with the discretionary order of the trial court, more particularly when the interim order of the trial court remains effective for a comparatively long period.

12. In the present case, it is apparent that the order of the learned single Judge has been kept in abeyance by virtue of interim order of stay granted by the Division Bench. The learned single Judge, while granting interim injunction, had not at all considered the question of violation of the design. On the other hand, the learned single Judge seems to have examined the matter in the light of action for passing off, for which apparently there was no adequate materials in the pleadings and even no prayer made in the plaint. We are unable to sustain such order.

13. In view of the above conclusion, the appeal is bound to be allowed. Therefore, it is not necessary to consider the other contentions raised by the learned Senior Counsel for the appellants, particularly the contention relating to invalidity of the registration of the design on the ground that there was publication of the design of the tyre even before the same was registered, thereby violating Section 4(b) read with Sections 19 and 22 of the Designs Act, 2000.

14. The appeal is accordingly allowed. Keeping in view the nature of dispute, we, however, feel in the interest of justice that the suit itself should be disposed of at an early date without being influenced by the observations made in the order of the learned single Judge or the present judgment. Accordingly, if the plaintiff moves before the learned single Judge, the learned single Judge may consider the request for an early hearing. Consequently, the connected miscellaneous petition is closed.

(P.K.M.,J) (K.C.,J)
29-04-2008
Index : Yes / No
Internet: Yes / No
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To

The Sub-Asst. Registrar, Original Side, High Court,Madras

P.K. MISRA, J
and
K. CHANDRU, J

JUDGMENT IN OSA.287/2006

29-04-2008